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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/512,036	06/22/2005	Heinz Kleinerusskamp	SZY10082P0070	2219
32116	7590	04/17/2006	EXAMINER	
WOOD, PHILLIPS, KATZ, CLARK & MORTIMER 500 W. MADISON STREET SUITE 3800 CHICAGO, IL 60661			FLETCHER III, WILLIAM P	
			ART UNIT	PAPER NUMBER
			1762	

DATE MAILED: 04/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/512,036	Applicant(s) KLEINERUSSKAMP ET AL.	
	Examiner William P. Fletcher III	Art Unit 1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/20/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This application is a 371 of PCT/EP03/04247, filed 04/24/2003, published as WO 2003/091470 A3.

Response to Amendment

2. The preliminary amendment filed 10/20/2004 is noted. Claims 16-32 are now pending.

Priority

3. Receipt is acknowledged of papers (EP 02009270.6) submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

4. The information disclosure statement (IDS) submitted on 10/20/2004 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Specification

5. The abstract of the disclosure is objected to because it uses terms that are implied (see below). Correction is required. See MPEP § 608.01(b).
6. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

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The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

7. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

8. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: METHOD FOR IMPROVING CHARACTERISTICS OF RESIN COATED PAPER COMPRISING APPLYING A SOLUTION OF ONE OR MORE ALKALINE METAL SALTS.

9. The use of various trademarks has been noted in this application. Trademarks should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 16-32 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for improvement of the specific properties described in the specification, does not reasonably provide enablement for any and all effects, criteria, etc., as recited in claim 16. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

The specification, in various places, describes specific properties (such a gloss) that are “improved” according to the invention. The recitation “improving the metal effects and further processing criteria as well as the flexibility” is open to any and all sorts of metal effects, processing criteria, and flexibility. Consequently, the specification is not enabled for these other, unspecified properties included by the breadth of this claim language.

Claims 17-32 are similarly rejected by virtue of their incorporation of this subject matter.

12. Further, the specification, while being enabling for a gravure printing method by a fond cylinder, does not reasonably provide enablement for any other “adequate method,” as recited in claim 17. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

The specification discloses, as the sole means of application, gravure printing by a fond cylinder. Claim 17, in reciting “another adequate method” is open to any and all unspecified methods of application. Further, as detailed below, this limitation is indefinite because it is unclear whether the other method has to be adequate simply to apply the material or adequate to provide some other property, such as adhesion, thickness, etc. As such, it is unclear what methods are included and which are excluded, which exacerbates the lack of enablement for these methods.

Claim 19 is similarly rejected by virtue of its incorporation of this subject matter.

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claims 16-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

15. Claim 16 recites “improving the metal effects and further processing criteria,” which is indefinite for two reasons.

One: the term “improving” is a relative term which renders the claim indefinite. The term “improving” is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The specification provides no definition or means/criteria for identifying/ascertaining what constitutes an “improvement” within the context of the invention. Because it is unclear how much of what constitutes an improvement, the metes and bounds of the claim are impossible to determine.

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Two: the effects and processing criteria improved are not explicitly defined and, consequently, the claim is open to any and all such effects and criteria. Clearly the claim cannot improve any and all effects and criteria, so it is unclear which are included and which excluded by the claim. Consequently, the metes and bounds of the claim are impossible to determine.

Claims 17-32 are similarly rejected by virtue of their incorporation of this subject matter.

16. Claim 16 recites "one or more alkaline metal salts delaying hardening is applied," which is indefinite.

It is unclear just what hardening the alkaline metal salts delay: hardening of the ink? hardening of the solution itself? hardening of the resin? Consequently, the metes and bounds of the claimed subject matter are impossible to determine.

Claims 17-32 are similarly rejected by virtue of their incorporation of this subject matter.

17. Claim 17 recites "or another adequate method," which is indefinite.

The term "adequate" is a relative term which renders the claim indefinite. The term "adequate" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

This term is indefinite because it is unclear just what the method has to be adequate to achieve. Does the method have to be adequate simply to deliver the material to the substrate? to achieve a particular degree of adhesion? to impart a particular property? Consequently, because it is impossible to determine which of these unspecified methods is/are included or excluded, the metes and bounds of the claimed invention are impossible to determine.

Claim 18 is similarly rejected by virtue of its incorporation of this subject matter.

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18. The term “desired” in claims 18 and 25 is a relative term which renders the claim indefinite. The term “desired” is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

The specification provides no definition or means/criteria to establish what concentrations are “desired” within the context of the invention. Because it is impossible to determine which concentrations are included/excluded, the metes and bounds of the claimed subject matter are impossible to determine.

Claims 19 and 26 are similarly rejected by virtue of their incorporation of this subject matter.

19. Claims 20 and 27 are indefinite because it is unclear with respect to what the % proportion is measured: the solids content of the ready-to-print preparation? the total weight of the ready-to-print preparation? something else? Consequently, the metes and bounds of the claimed subject matter are impossible to determine.

20. Claims 22, 23, and 29 are indefinite because it is unclear how the application depends on the fond volume and the machine speed. What exactly is determined by or adjusted in response the fond volume and the machine speed? Further, in what way are these parameters dependent (i.e., inversely-proportional, directly-proportional, etc.)?

Claims 23 and 30 are similarly rejected by virtue of its incorporation of this subject matter.

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21. Regarding claim 24, the parenthetical renders the claim indefinite because it is unclear whether the limitations within the parenthetical are part of the claimed invention. See MPEP § 2173.05(d).

Claims 25-32 are similarly rejected by virtue of their incorporation of this subject matter.

22. The term “higher” in claim 24 is a relative term which renders the claim indefinite. The term “higher” is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

The specification provides no definition or means/criteria to establish what concentrations are “higher” within the context of the invention. Because it is impossible to determine which concentrations are included/excluded, the metes and bounds of the claimed subject matter are impossible to determine.

Claims 25-32 are similarly rejected by virtue of their incorporation of this subject matter.

23. Claim 26 recites “the mixture according to claim 25,” which is indefinite because claim 25 is a method claim.

Because it is unclear whether applicant intends to recite a method claim or a composition claim, the metes and bounds of this claim are impossible to determine.

24. Finally, claim 31 is indefinite for several reasons.

One: the term “impregnating” lacks antecedent basis in the claims. Nowhere in the claims is a step of impregnating recited. Further, nowhere is it specified exactly what is being impregnated. Consequently, the metes and bounds of the claim are impossible to determine.

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Two: the parenthetical renders the claim indefinite because it is unclear whether the limitations within the parenthetical are part of the claimed invention. See MPEP § 2173.05(d). Further, it is noted that silicic acid and silicon dioxide are not synonyms.

Three: it is unclear just what is coated with titanium dioxide. Is it the substrate? the resins? the pigment? or something else entirely? Consequently, the metes and bounds of the claimed invention are impossible to determine.

Claim 32 is similarly indefinite by virtue of its incorporation of this subject matter.

Conclusion

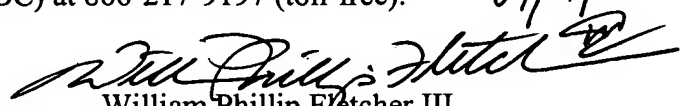
25. The prompt development of clear issues in the prosecution history requires that applicant's reply to this Office action be fully responsive (MPEP § 714.02). When filing an amendment, applicant should specifically point out the support for any amendment made to the disclosure, including new or amended claims (MPEP §§ 714.02 & 2163). A fully responsive reply to this Office action, if it includes new or amended claims, must therefore include an explicit citation (i.e., page number and line number) of that/those portion(s) of the original disclosure which applicant contends support(s) the new or amended limitation(s).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571) 272-1419. The examiner can normally be reached on Monday through Friday, 9 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

04/14/2006

William Phillip Fletcher III
Patent Examiner (PSA), USPTO
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